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PATENT

IN THE U.S. PATENT AND TRADEMARK OFFICE

Appellants: Reinhold OTT Conf.: 8372
Appl. No.: 10/532,231 Group: 2162
Filed: January 18, 2006 Examiner: Shirley Lu
For: RETAINING COMPONENT FOR SECURING ITEMS
Docket No.: 40770-000164/US

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Mail Stop Appeal Brief – Patents

September 21, 2009

REPLY BRIEF

Sir:

The following comments are directed to the points of arguments and comments raised in the Examiner's Answer mailed August 21, 2009.

I. Claim Interpretation

In the Response to Arguments section of the Reply Brief beginning at page 11(a), the Examiner alleges that Leyden discloses a retaining component that includes an “elastically deformable material.”

Leyden discloses a security apparatus for monitoring an article to prevent unauthorized removal of the article. In Leyden, the security apparatus 60 includes a housing 68 that contains all of the electrical components of the security apparatus 60. The housing 68 is made of a rigid material, such as a hard plastic (col. 6, lines 8-11). The apparatus 60 also includes a body 62 made of a material that can be configured into a plurality of shapes and maintain itself in the plurality of different shapes. Once the material of the body 62 is conformed to a particular article, the body will not spring back to its undeformed shape. As a result, a positive bond between the body 62 and

the article 88 being protected can be maintained without fear of peeling off by reason of its own reconfiguration (col. 2, line 61-col. 3, line 4; col. 6, lines 46).

Thus, in contrast to the claimed retaining component that includes “elastically deformable material,” the body 62 is not an elastically deformable material. Rather, as clearly described in Leyden, the body 62 “once conformed...will not spring back to its undeformed state” and therefore is not elastically deformable. Although this fact has been argued during prosecution and pointed out in the Appeal Brief, the Examiner maintains the incorrect interpretation of the claim term. For example, the Examiner states that the claim term “elastically deformable material” has been given “the broadest reasonable interpretation.”

As previously pointed out during examination and in the Appeal Brief, during examination, “claims yet unpatented are to be given their broadest reasonable interpretation consistent with the specification during an examination of a patent application” (emphasis added) *Phillips v. AWH Corp.*, 415 F.3d 1303, 75 USPQ2d 1321 (Fed. Cir. 2005), *In re Prater*, 415, F.2d 1493 (1969). This standard is also provided as the standard for claim interpretation under MPEP §2111 which recites that “during patent examination the pending claims must be given the broadest reasonable interpretation consistent with the specification.” The Patent and Trademark Office (“PTO”) determines the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction “in light of the specification as it would be interpreted by one of ordinary skill in the art” (emphasis added). *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364[, 70 USPQ2d 1827] (Fed. Cir. 2004). Indeed, the rules of the PTO require that application claims must “conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description.” 37 CFR 1.75(d)(1) (MPEP §2111).

The specification is the “primary basis for construing claims” and is the “single best guide to claim meaning” because the specification, as set forth by statute, describes the claimed invention in full, clear, concise and exact terms *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005). According to *Phillips*, first, the claim language, specification, and prosecution history (intrinsic evidence) are the primary sources for claim construction. Second, the trial court may use other evidence, including dictionaries, treatises, and expert testimony (extrinsic evidence) to understand the technology at issue and as part of the claim construction process. Extrinsic

evidence, however, may not be used to reach a claim construction that is inconsistent with the intrinsic evidence. Third, the principle that “claims should be construed to uphold their validity” has very narrow applicability.

Rather than apply this clear standard of claim interpretation, the Examiner applies a “broadest reasonable interpretation” standard without considering any of the specification, prosecution history, or other extrinsic evidence, such as a dictionary, treatise or other source. For example, in the Response to Arguments section of the Examiner’s Answer, the Examiner alleges that according to the “broadest reasonable interpretation” the claim feature of an “elastically deformable material” is one that is capable of “change/expansion/contraction, not rigid or constructed.” As pointed out during examination and in the Appeal Brief, the Examiner failed to cite any authority for the applied definition and therefore, the interpretation is without merit. Additionally, even accepting *arguendo* the Examiner’s unsubstantiated definition, when the material of the body 62 is conformed to a particular article, the body will not spring back to its undeformed shape. As a result, a positive bond between the body 62 and the article 88 being protected can be maintained without fear of peeling off by reason of its own reconfiguration (col. 2, line 61-col. 3, line 4; col. 6, lines 46). Therefore, the body of Leyden fails to meet the Examiner’s definition.

Turning to the specification for guidance in interpreting the claim language, the specification recites that the retaining component preferably consists of an elastically deformable material (pg. 3, paragraph 2). The specification further describes that the retaining component can be adjusted to nearly any randomly rounded items due to the elastic deformation of the second retaining area (pg. 7, paragraph 3). The claimed elastically deformable retaining component is specifically distinguished from the material used in Leyden at page 2, paragraph 1 of the specification of the present application. Thus, interpreting the device of Leyden as being elastically deformable is inconsistent with the specification.

Further, from the Examiner’s interpretation of the term “elasticity” it appears that the Examiner confuses the terms elasticity and plasticity. For example, “elasticity” has a well-known definition in the art that denotes a special type of deformation, rather than the mere ability to be deformed under the effect of external forces. For example, the *Encyclopedia Britannica* describes elasticity as “enabling a solid to return to its original shape after the load has been removed.” *The American Heritage Dictionary*, 3rd Ed. defines elasticity as the property of being elastic (i.e., easily

resuming original shape after being stretched or expanded; flexible). In contrast, the *Encyclopedia Britannica* describes plasticity as “enabling a solid, under the action of external forces, to undergo permanent deformation without rupture.” *The American Heritage Dictionary*, 3rd Ed. defines “plasticity” as capable of being formed or shaped; having the qualities of sculpture. Therefore, while the thermal setting rubber of Leyden used to make the device may be plastic, it is not an elastically deformable material.

As discussed above, Leyden specifically describes that the body is made of a material that can be conformed to a particular article but will not spring back to its undeformed state. These characteristics are in keeping with a goal of Leyden to prevent the body from peeling off of an article “by reason of its own reconfiguration” (col. 2, line 61-col. 3, line 2).

Thus, when properly interpreted, Leyden fails to disclose an “elastically deformable material.” Rather, as discussed, Leyden merely describes the body being “made from a material that can be reconfigured into a plurality of shapes and maintains itself in the plurality of different shapes” (i.e., plastic).

Because of this well-known difference between elastic materials and plastic materials, Leyden actually teaches away from the use of the claimed “elastically deformable material” because every embodiment of Leyden is related to a plastically deformable material that does not have a tendency to peel off (col. 6, lines 43-46). Thus, Leyden does not disclose the structural arrangement of the claims as alleged.

II. Claim 7

Claim 7 recites, in part “wherein the first retaining area and the second retaining area include the same material.” In the Response to Arguments section of the Examiner’s Answer beginning at page 11 (b), it is alleged that the “first retaining area is the top area of apparatus 60 that is of the material 62, and the second retaining area is the bottom are of apparatus 60 that is of the material 62.” However, such an interpretation is inconsistent with the features as claimed. For example, claim 7 includes the features of claim 1. Claim 1 recites that “the first retaining area” is the area for fastening the retaining component to a fastening component. Therefore, the first retaining area of Leyden must be the area 68 (housing) that houses the strain relief cord 74. The housing 68 is clearly described in Leyden as being of a hard plastic (col. 6, lines 9-11).

Claim 1 further recites that the second retaining area fastens the retaining component to the item to be secured (i.e., the body 62 of Leyden made of a thermal setting rubber, for example). Therefore, as argued during examination and pointed out in the Appeal Brief, Leyden does not disclose or suggest first and second retaining areas that include the same material.

III. Motivation to Combine

It is asserted in the Response to Arguments section of the Examiner's Answer beginning at page 12(c), that the secondary reference of Jagger is combinable with the primary reference of Leyden because Jagger is either in the field of applicants endeavor or, if not, then is reasonably pertinent to the particular problem with which the applicant was concerned (relying on *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992)). The Examiner alleges that "Jagger is at least reasonably pertinent to the particular problem with which the applicant was concerned. Specifically, Jagger discloses a conventional use of a capacitive switch and an optical sensor for sensing purposes."

In determining whether particular references are within the appropriate scope of art, the Federal Circuit has adopted a two step test (*In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986)). First, it must be determined whether the reference is within the field of the inventor's endeavor, and second, assuming the reference is outside that field, it must be determined whether the references are "reasonably pertinent" to the particular problem with which the inventor was involved. The court pointed out that a reference cannot be considered to be within the inventor's field of endeavor merely because both relate to the same industry.

In this case, the inventor's field of endeavor is that of securing items from theft by attaching an item to be secured to a retaining system. In contrast, the field of endeavor of Jagger is of cereal milling machines that grind stock stored in a hopper using grinding rolls. Thus, Jagger is in no way in the inventor's field of endeavor.

Second, the court indicated that a reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to the inventor's attention in considering his problem (*In re Clay*, 966 F.2d 656, 23 USPQ 2nd 1058 (Fed Cir. 1992)).

As the object of Jagger is to provide a cereal milling machine having a stock level sensing means with consequent control of the feed stock, Jagger relates to problems completely unrelated

with the problems being addressed in the present application, and therefore is cannot be said to be “reasonably pertinent” to the inventor’s problem.

IV. Conclusion

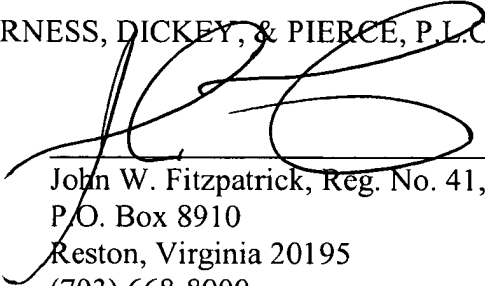
It is respectfully submitted that the remaining points of arguments set forth in the Examiner’s Answer were fully addressed in the Appellants Appeal Brief. For at least the reasons set forth herein and then the Appeal Brief, it is respectfully submitted that the pending claims are in condition for allowance.

The Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

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